



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/628,804 | 07/28/2000 | Norbert Venet | Q60260 | 3500 |

7590 12/10/2003

Sughrue Mion Zinn MacPeak & Seas PLLC
Suite 800
2100 Pennsylvania Avenue NW
Washington, DC 20037-3213

[REDACTED] EXAMINER

TUGBANG, ANTHONY D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| | 3729 |

DATE MAILED: 12/10/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-------------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/628,804 | VENET ET AL. |
| | Examiner A. Dexter Tugbang | Art Unit 3729 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 March 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-3 and 8-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,8 and 11 is/are rejected.
- 7) Claim(s) 2,3,9 and 10 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 17. 6) Other:

DETAILED ACTION

Response to Amendment

1. The applicants' amendment filed 3/13/03 (Paper No. 18) has been fully considered and made of record.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Specification

3. The applicants' arguments regarding the withdrawal of the objection to the specification have been found to be persuasive and the applicants' remarks (Paper No. 18, pages 1-2) are fully incorporated by reference herein. Accordingly, the objection to the specification is the previous Office Action has been withdrawn.

Claim Rejections - 35 USC § 102

4. Claims 1, 8 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Noguchi et al 5,959,846.

Regarding Claim 1, Noguchi discloses a method of obtaining a module comprising: forming a stacked assembly (shown in Fig. 11) by stacking the plurality of aligned modular printed circuit film elements (substrates 6a, 6b) carrying a set of turns (radial connections 5b) of conductive tracks 4 which form part of the inductive winding and the conductive tracks 4 terminate near an edge of the modular printed circuit film (example shown in Fig. 1); molding an insulative material (resin 30) over the stacked assembly of modular printed circuit film elements to constitute a rigid block (see col. 7, lines 45-49); cutting the rigid block laterally (at cut lines 7

and 8) to expose an end for each of the conductive tracks 4 and so that the exposed ends are flush with a surface of one face of the block (see Fig. 12b); and creating connections on the one face of the block with which the exposed ends are flush to selectively interconnect the one conductive tracks and to connect the tracks to connection means external to the module (see examples of external connection means at col. 2, lines 25-29).

Regarding Claim 8, Noguchi teaches all of the limitations as relied upon above in Claim 1 and further including that the claimed “first support” and “second support” is read as substrates 6a, 6b.

Regarding Claim 11, Noguchi further teaches the first and second conductive tracks 4 are formed before the stacking step (see col. 6, line 36 to col. 7, line 10).

Response to Arguments

5. The applicant's arguments filed 3/13/03 (Paper No. 18) have been fully considered, yet have not been deemed to be found as persuasive.

In regards to the merits of Noguchi et al, the applicants' believe that Noguchi does not teach “printed circuit elements carrying a set of turns of one or more conductive tracks” (as required by Claim 1, lines 5-7) and similar limitations of “at least a first conductive track carrying a set of turns of one or more conductive tracks” (as required by Claim 8, lines 3-4).

The examiner most respectfully disagrees. In Noguchi, the limitations of the set of turns and conductive tracks were read as the radial connections 5b and electrodes 4, respectively. The examiner notes Figure 7 of Noguchi, which shows the same cross-hatched area for both the radial connections 5b and electrodes 4. This cross-hatched area for both of the radial

connections 5b and electrodes 4 shows turns of 90° angles for each. Because each functions as a conductor in an inductive winding, the limitations of “printed circuit elements carrying a set of turns of one or more conductive tracks” (as required by Claim 1) and similar limitations of “at least a first conductive track carrying a set of turns of one or more conductive tracks” (as required by Claim 8) are fully satisfied by Noguchi.

The applicants’ further argue that Noguchi does not teach “molding an insulative material over the stacked assembly of the modular printed circuit film elements to constitute a rigid block” (as required by Claim 1, lines 10-11) and “molding an insulative material over the stacked assembly to form a block” (as required by Claim 8, line 10). The applicants’ place a great deal of emphasis on the phrase of “rigid block” or “block.”

Again, the examiner most respectfully disagrees. It is noted that transfer molding as discussed by Noguchi, whether the insulative material is deposited or not, is still molding or a form of molding that applies the insulative material over the stacked assembly. The final structure of the stacked assembly, inclusive of the insulative material, is what forms the block or rigid block. For example, *after* the insulative material of resin is applied by transfer molding, the resulting final structure is considered to be a rigid block. The insulative material would not stay in a state of transfer molding, but contributes to the state of the final structure of the overall assembly. Therefore, Noguchi fully satisfies the limitations of “molding an insulative material over the stacked assembly of the modular printed circuit film elements to constitute a rigid block” (as required by Claim 1) and “molding an insulative material over the stacked assembly to form a block” (as required by Claim 8).

Allowable Subject Matter

6. Claims 2, 3, 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dexter Tugbang whose telephone number is 703-308-7599. The examiner can normally be reached on Monday - Friday 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone numbers for the

Art Unit: 3729

organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3588 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



A. Dexter Tugbang
Primary Examiner
Art Unit 3729

December 9, 2003